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Appln. No. 09/751,801
Amendment dated June 6, 2006
Reply to Office Action mailed March 8, 2006

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 5, 7 through 22 and 24 through 49 remain in this application. Claims 6 and 23 have been cancelled. No claims have been withdrawn or added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Parts 1 and 2 of the Office Action

Claims 1 through 5, 7 through 22, 23 through 43 and 45 through 49 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Dowling in view of Scimone.

Claim 44 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Dowling in view of Scimone and further in view of McAuliffe.

Claim 1 requires "modifying the acceptance data by integrating at least one entry from a personal information manager" and "wherein the step of modifying the acceptance data includes converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry, and adding the at least one product to the acceptance data to accept advertisements for the at least one product". Claim 14 requires "creating preferences for selecting advertisements" and "wherein the step of creating the preferences for selecting advertisements includes converting at least one entry from a personal information manager into at least one product that corresponds to the at least one entry, and modifying the preferences to select advertisements for the at least one product from the one or more broadcast advertisements received by the communication device". Claims 19 and 28 require (similarly, but not

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identically) "logic for modifying the acceptance data by integrating at least one entry from a personal information manager, wherein the logic for modifying the acceptance data includes logic for converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry, and logic for adding the at least one product to the acceptance data to accept broadcast advertisements for the at least one product". Claim 33 requires "a mobile communication device capable of storing acceptance data thereon, the mobile communication device being capable of modifying the acceptance data by integrating at least one entry from a personal information manager, the mobile communication device being capable of converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry, and adding the at least one product to the acceptance data to accept advertisements for the at least one product".

While the Dowling patent is relied upon as the primary reference in the rejection of claims 1 through 5, 7 through 22, 23 through 43 and 45 through 49, it is conceded in the rejection of the Office Action that Dowling "fails to teach [] a personal information manager." It is then contended in the rejection that:

However, Scimone teaches a personal digital assistance computer (see Scimone column 5, lines 44-47) with personal information manager software (see Scimone figure 600 "Microsoft Outlook" column 7, lines 60-65). Users of said PDAs use said PMI software to enter preference data (see Scimone column 8, lines 45-50), which is used to filter the information that is transmitted to said users (see Scimone column 9, lines 5-15).

It is further asserted in the rejection of the Office Action that:

Dowling teaches in column 17, lines 60-67 that "In another example the mobile unit 105 is implemented as a palm-pilot or personal digital assistant computer".

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It is then contended that:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dowling's PDA mobile device would have a PIM software installed in said device, as taught by Scimone in view that said PIM software would be able to search and obtain external data from the Internet (see Scimone column 21, lines 50-55) and also in view that said PIM software would allow users to filter said external data that would be transmitted to said users in said PDA, as taught by Scimone.

It is then further contended

Dowling would have been motivated to include a PIM software in a PDA device in view of society's demand for virtually instantaneous access to information and to make it easier to access and input data into said mobile device.

It appears that the main focus of the remarks in the rejection are to make a case for a PDA utilizing the Dowling system to also include PIM software installed on the PDA, and then assert that in this environment the actions required by the claims would occur. However, it is submitted that even if one accepts for the purposes of argument that the allegedly obvious combination leads one of ordinary skill in the art to PIM software on a PDA, and even if one accepts (for the purposes of argument only) that the PIM software has the ability to "search and obtain external data from the Internet" and filter "external data that would be transmitted to said users in said PDA", it is contended that this would still not lead one of ordinary skill in the art to the particular requirement of the claims of "modifying the acceptance data by integrating at least one entry from a personal information manager" and "wherein the step of modifying the acceptance data includes *converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry*, and adding the at least one product to the acceptance data to accept advertisements for the at least one product" (emphasis added).

More specifically, the portions of the Scimone patent that are referenced in the rejection will be considered. The Scimone patent in

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general discusses software for providing access to a "dynamic datastream" of news and financial data. In the first portion of Scimone referenced in the Office Action, Scimone states at col. 5, lines 44 through 47 that:

Correspondingly, information appliances 160 can be remote personal computers, handheld personal digital assistants with wireless capability, cellular phones, pagers, and the like.

And states at col. 7, lines 44 through 47 that:

Information appliance 600 for convenience of explanation corresponds to workstation 120 in FIG. 1, although it is understood that any of information appliances 150, 160 can be substituted therefore. Information appliance 600 contains, in the preferred embodiment shown in FIG. 2, Outlook software 610 and a plurality of COM Add-Ins 620.

It is thus apparent from these portions of Scimone that the Scimone system may be implemented on an information appliance that may be a PDA, and the information appliance may include "Outlook" software. Scimone further states at col. 8, lines 40 through 52 that:

By assigning news item details to specific fields, the standard filters and other features of Microsoft Outlook can be utilized to tailor the news information to the specific needs of the user. For example, just as a client using e-mail can use filters to receive only messages from certain authors or about certain subjects, the client using the present invention may decide to only view news articles written by a certain writer or about a certain topic. Further, similar to a user double-clicking on a displayed subject field to view a corresponding mail item, a user of the present invention need only double-click on a displayed headline of a mail object to retrieve a news story from a story field of the mail object.

Thus, the Scimone system may utilize the Outlook software to receive and filter emails from the Headline Distributor, as stated at the referenced portion of Scimone in col. 9, lines 4 through 13:

Each Headline Distributor examines its filter criteria to determine if the headline is of interest; these filter criteria were previously set by the user of information appliance 600 utilizing the mail message filtering tools that are provided with Outlook software 610. If a headline is of interest, the Headline Distributor inserts the Headline into a mail item in its database. In addition, in the event of such interest, the Headline Distribution Manager makes a request to

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data source 310 for the text of the story. These events are shown in step 3020 of FIG. 3A.

The Scimone system thus receives content from the proprietary news and financial data distribution portion of Scimone's system, and filters that data using the filters that are set in the Outlook software. This proprietary flow of information from the Scimone system servers is thus subject to being filtered based upon subject matters filters and author filters that the use of the information appliance may have set up. However, nothing in Scimone suggest that the Outlook filters are employed to filter anything other than this proprietary content from the Scimone servers. The rejection thus points to Scimone at col. 21, lines 45 through 54, that states:

Internet Sub-View: The Internet Sub-View 1420, shown in FIG. 8, displays search results within a web browser that are received from an Internet search engine, "Alta Vista" in the case of FIG. 8. This is accomplished by setting the Sub-View to a folder on server 520, shown in FIG. 2, which contains an ASP script, coded with an Alta Vista search string. The search criteria is passed into this string via News COM Add-In 622, as previously described. The Alta Vista search engine performs the search and the results are displayed via HTML in the web browser.

However, nothing is said about any filtering of the data retrieved from the Internet, particularly when an Internet search is performed. It is submitted that this feature of Scimone is merely a window for displaying the results of an Internet search within the larger window of the program, as does not offer any filtering above what may be performed by the (Alta Vista) search engine.

One must keep in mind that the requirements of the claims are not general in nature—claim 1 requires "converting the *at least one entry* from the personal information manager *into at least one product* that corresponds to the at least one entry, and *adding the at least one product to the acceptance data to accept advertisements for the at least one product*". The Scimone patent discusses using various filter settings of the Outlook program to filter incoming email that happens to have been generated by the

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Scimone server and contains news and financial data. But nothing in the Scimone patent suggests that an entry in a PIM is converted into a corresponding product, and that the product is then added to acceptance data. One of ordinary skill in the art, considering the disclosure of Scimone, is led to understand that it is the user that sets the filters, and there is no discussion of converting the filter settings into anything else—one understands that the Outlook software operates normally on email that it receives, and it is only in the preparation of the email with specialized subject lines and author info that is manipulated so that the Outlook filters can act normally on it. Further, the rejection does not explain how one of the news and financial data filters could be converted into any particular product.

Turning now to the Dowling patent, it is noted that nothing in the Dowling patent appears to suggest any importation of any "acceptance data" from another source, particularly a PIM, and particularly an entry in a PIM that is then converted into product used to create acceptance data for product advertisements. It has been noted that the Dowling patent states at col. 17, line 60 through col. 18, line 6, that (emphasis added):

In another example the mobile unit 105 is implemented as a palm-pilot or personal digital assistant computer. A user carrying the palm-pilot version of the mobile unit 105 enters a shopping mall and is looking for a silver plated picture frame under fifty dollars. Information to this effect is entered by the user as discussed above and a user-interest packet is transmitted according to the first step 515. The local broadcast domain entity 150 is preferably controlled by the shopping mall authorities or a contracted advertising company. The steps 520 and 525 then are performed to determine which stores carry the item of interest. If any of the stores within the shopping mall carry the item of interest, the decision 530 evaluates affirmatively and a packet will be transmitted back to the mobile unit 150 as discussed below.

While this portion of the Dowling disclosure does discuss the use of the system on a PDA, there is no teaching or suggestion of any transfer of information from another program, particularly a PIM, to the Dowling

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system. The possibility of implementing the Dowling system on a PDA does not clearly or necessarily lead one of ordinary skill in the art to any exchange of information between a PIM and the Dowling system. In fact, the description here in Dowling clearly indicates that the product identity information is entered by the user, and not transferred from any other program such as a PIM. It is therefore submitted that the Dowling patent would not lead one of ordinary skill in the art to "converting the at least one entry from the personal information manager into at least one product that corresponds to the at least one entry, and adding the at least one product to the acceptance data to accept advertisements for the at least one product", as required by claim 1.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Dowling, Scimone and McAuliffe set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1 through 5, 7 through 22 and 24 through 49 and therefore is submitted to be in condition for allowance.

Withdrawal of the §103(a) rejections of claims 1 through 5, 7 through 22, and 24 through 49 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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